

REMARKS / ARGUMENTS

The present application includes pending claims 1-25, all of which have been rejected. By this Amendment, claims 1-25 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-4, 6-8, and 10-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0059621, issued to Thomas, et al. (hereinafter, Thomas), in view of U.S. Patent No. 6,055,314, issued to Spies, et al. (hereinafter, Spies). Claims 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas and Spies, in view of U.S. Patent No. 7,134,131, issued to Hendricks, et al. (hereinafter, Hendricks). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis

supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Thomas and Spies Does Not Render Claims 1-4, 6-8, and 10-25 Unpatentable

The Applicant now turns to the rejection of claims 1-4, 6-8, and 10-25 as being unpatentable over Thomas in view of Hendricks.

A. Independent Claims 1 and 17

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Thomas and Spies does not disclose or suggest at least the limitation of "a card carrying information related to one or more user-defined selections of the information content, wherein the card allows the at least one communication device to access the user-defined selections identified by the card, once the card is communicatively coupled to the at least one communication device," as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

Thomas fails to disclose a card carrying information related to one or more user-defined selections of the information content; wherein the card allows the at least one communication device to access the user-defined selections identified by the card, once the card is communicatively coupled to the at least one communication device.

Spies, in the same field of media exchange; discloses a card (These decryption capabilities are stored on an integrated circuit (IC) card, such as a smart card or PCMCIA card, that is issued to the viewer. **The IC card is configured with cryptographic functionality to support the secure purchase of the decryption capabilities from the video merchant.** The IC card can then operate in conjunction with a viewer's set-top box (STB), DVD player, or other video computing device to decrypt a video stream of the selected video content program using the purchased decryption capabilities stored on the IC card without exposing those capabilities to the viewer or video computing device; see US'314, col. 2 lines 31-42) **carrying information related to one or more user-defined selections of the information content (the IC card has a pair of public and private exchange keys and a pair of public and private signing keys.** When the purchaser selects a video, the IC card digitally signs the order using the private signing key and passes a credential with

the public exchange and signing keys to the video merchant computing unit; see US'314, col. 3 lines 19-24)

See the Final Office Action at pages 3-4 (emphasis added). The Examiner has conceded that Thomas fails to disclose a card carrying information related to one or more user-defined selections of the information content; wherein the card allows the at least one communication device to access the user-defined selections, as recited in Applicant's claim 1. The Examiner then relies for support on numerous citations from Spies. In fact, pages 3-5 of the Final Office Action provide extensive summaries of the subject matter of Spies relating to the IC card. By the Examiner's own admission (see bolded portions above), Spies' IC card is configured with cryptographic functionality and is used to support the secure purchase of the decryption capabilities from the video merchant. More specifically, Spies' IC card is simply used to store the public and private exchange and signing keys that are used to decrypt the video data stream provided from the distribution medium. See Spies at Abstract and col. 3, lines 36-51. In this regard, Spies' IC card is not used to carry any information related to user-defined selections of information content. Furthermore, the IC card is also not used to access user-defined selections identified by the card.

Therefore, the Applicant maintains that the combination of Thomas and Spies does not disclose or suggest at least the limitation of "a card carrying

information related to one or more user-defined selections of the information content, wherein the card allows the at least one communication device to access the user-defined selections identified by the card, once the card is communicatively coupled to the at least one communication device," as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Thomas and Spies does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 10, 17, and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 10, 17, and 21 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-4, 6-8, 11-16, 18-20, and 22-25

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 10, 17, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Spies has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-4, 6-8, 11-16, 18-20, and 22-25 depend from independent claims 1, 10, 17, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-4, 6-8, 11-16, 18-20, and 22-25.

II. The Proposed Combination of Thomas, Spies, and Hendricks Does Not Render Claims 5 and 9 Unpatentable

Claims 5 and 9 depend from independent claim 1, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5 and 9.

In general, the Final Office Action makes various statements regarding claims 1-25 and the cited reference that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-25 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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